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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,085	03/10/2000	Douglas S. Foote	9137.00	5683

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EXAMINER

PWU, JEFFREY C

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,085

Applicant(s)

FOOTE ET AL.

Examiner

Jeffrey Pwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 15-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 15-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-8 and 15-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suer et al. (US 6,431,439) in view of Terranova et al. (US 2001/0045457).

Suer teaches a method and an apparatus comprising:

- identifying an ATM (SST) which has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands; and modifying said ATM to enable it to receive from a wireless telephone user commands for dispensing cash (col.3, line 54-col.4, line 43; 63-fig.2A; col.13, lines 17-40);
- wherein said transceiver is further adapted to transmit signals directly to said wireless telephone (col.4, lines 8-65).
- wherein said signals implement local wireless communication (col. 13, lines 17-col.4, line 17);
- wherein said ATM is connected to a network for communication therebetween, and wherein said modifying step includes providing a connection between said network and said wireless device (col. 13, lines 17-col.4, line 17);
- wherein said modifying step includes retrofitting the ATM with a transceiver adapted to receive signals directly from the wireless telephone (fig.6, steps 161-162);)!-wherein the transceiver is connectable to a system bus of a computer within the ATM (col.4, lines 30-42);
- a self-service terminal having been retrofitted to allow the terminal to execute transactions entered using a wireless telephone, wherein said terminal did not allow transactions to be entered using a wireless telephone prior to retrofitting (abstract; Col. 1, lines 13-15; col.3, lines 9-16, 41-50, 55-67, col.4, lines 8-15, 30-53, and Col. 13, lines 20-23);and

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➤a self-service terminal having been retrofitted to receive a transaction from an authorized source external to the terminal, wherein said terminal did not allow transactions to be entered using a wireless telephone prior to retrofitting (abstract; Col. I, lines 13-15; col.3, lines 9-16, 41-50, 55-67, col.4, lines 8-15, 30-53, and Col. 13, lines 20-23).

However, Suer fails to show a wireless phone to withdraw cash from an ATM.

It is well know in the art to retrofit any controllable electronic device with a wireless transponder/receiver to control the device.

Terranova is applied for showing that is well know in art to use wireless technology, e.g. cell phones, palm pilots, & etc. to control a fuel pump/banking system by modifying an existing electronic controls with wireless communications between a dispenser or associated communications system and a remote communication unit or transponder carried by a person or mounted to a vehicle to control the system.

It would have been obvious to a person having skill in the art at the time of the invention to equip an ATM that dose not have the remote control communication system by using uer's device to communicate via a transponder/receiver as taught by Terranova to conduct business wirelessly.

Response to Arguments

3. Applicant's arguments filed 3/22/2004 have been fully considered but they are not persuasive.

4. In response to applicant's argument that no teaching given for combining reference, the test for obviousness is not whether the features of a secondary reference may be bodily

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incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is notoriously well known to combine, for example, the invention of the wireless TV remote in the 1960s, then the combination of both TV and VCR in one control simply for the convenience of using only module. Furthermore, Freeny, JR. (U.S 2002/0188575) is cited for showing a wireless phone system can be modified to allow users to access various services (such as Toll tag access, **ATM dispensing**, gas pump dispensing, store credit card checkout, garage door access, and multiple other functions. Therefore, it would have been obvious to a person

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having skill in the art at the time of the invention to use wireless technology to equip ATM to facilitate the control of an ATM wirelessly.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Pwu whose telephone number is 703 308-7835. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 703 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey Pwu



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JEFFREY PWU
PRIMARY EXAMINER